

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

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NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY

(PCT Rule 71.1)

Date of mailing
(day/month/year)

03.04.2006

Applicant's or agent's file reference
PU030224

IMPORTANT NOTIFICATION

International application No.
PCT/US2004/001747International filing date (day/month/year)
22.01.2004Priority date (day/month/year)
22.01.2004Applicant
THOMSON LICENSING S.A. et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

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preliminary examining authority:

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference PU030224		FOR FURTHER ACTION		See Form PCT/PEA/416
International application No. PCT/US2004/001747		International filing date (day/month/year) 22.01.2004		Priority date (day/month/year) 22.01.2004
International Patent Classification (IPC) or national classification and IPC INV. H04N7/00 H04N7/167 H04N7/173 H04N5/00				
Applicant THOMSON LICENSING S.A. et al.				
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> sent to the applicant and to the International Bureau) a total of sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in electronic form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>				
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>				
Date of submission of the demand 08.06.2005		Date of completion of this report 03.04.2006		
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465		Authorized officer Lindgren, J Telephone No. +49 89 2399-7620		



**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/001747

Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
 - ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

Description, Pages

1-8 as originally filed

Claims, Numbers

1-13 received on 08.06.2005 with letter of 08.06.2005

Drawings, Sheets

1/3-3/3 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☐ The amendments have resulted in the cancellation of:
 - ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify):*
 - ☐ any table(s) related to sequence listing *(specify):*
 4. ☒ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
 - ☐ the description, pages
 - ☒ the claims, Nos. 3,6-9
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify):*
 - ☐ any table(s) related to sequence listing *(specify):*

* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/001747

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-13
Inventive step (IS)	Yes: Claims	
	No: Claims	1-13
Industrial applicability (IA)	Yes: Claims	1-13
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

I Basis of the report

1. The claims 3 and 6-9 currently on file contain subject-matter extending beyond the content of the application as filed, contrary to Article 34(2)(b) PCT. A correspondence between said claims and the application as filed could not be established.

V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

2. The following documents are referred to in this communication; the numbering will be adhered to in the rest of the procedure:
D1: US 2002/044658 A1 (AKINS GLENDON L ET AL) 18 April 2002 (2002-04-18)
3. The present application consists of 5 independent claims and as such can not be considered to be drafted in a concise manner as prescribed in Article 6 PCT.
4. Independent claim 1
 1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 1 is not new in the sense of Article 33(2) PCT.
Document D1 discloses (the references in parenthesis applying to this document):
An access device (set top box (STB) 113, paragraph 0048) comprising:
a means for communicating an impulse purchase selection;
a means for receiving an authorization key in response to the impulse purchase selection;
a means for receiving a transmission of the impulse purchase.
a means for processing the received program using the authorization key.
(Paragraph 0099 discloses all of the features above)

The claim is thus not novel (Article 33(2) PCT).

2. If claim 1 was to be made novel (e.g., by adding one or several of the features of the dependent claims) or if the claim through creative interpretation would render D1 no longer novelty destroying, the claim would still not be considered

inventive (Article 33(3) PCT). Reasons are:

1. If one was to consider receiving authorization information upon an impulsive selection of a program by an access device as claimed in claim 1 novel or inventive, the teaching of paragraph 0048 of D1 (disclosing exactly this feature) is directed to "impulse purchase selections" and hence discloses the same idea as claim 1. It is correct that paragraph 0048 never mentions the word *impulse* but it is clear from e.g. paragraph 0099 that *impulse* pay per view IPPV is within the scope of D1 and it would be reasonable for a reader to interpret "a service may be a one-time event" of paragraph 0048 to encompass also IPPV.
 2. The disclosure of paragraph 0099 of D1 clearly reads on to the subject-matter of claim 1. Decryption by DHCT 333 is confirmed/authorized by the entitlement agent upon reception of EMM 315, where EMM 315 is in response to an FPM from the EMM manager 407 in DHCT 333.
5. Independent claim 2
The objections raised against claim 1 also apply to claim 2.
6. Independent claim 13
Since method claim 13 is merely a re-formulation of apparatus claim 1, the same objections raised against claim 1 are also valid for claim 13 *mutatis mutandis*.
7. Dependent claims
1. Claims 4 and 10, transmission/reception of authorization keys (EMM) via out of band frequency channels is disclosed in D1 (paragraph 0048).
 2. Claims 5 and 11, the message specifying a user's intention to buy an impulse PPV (IPPV) event is responded to by the entitlement agent (paragraph 0099). This necessitates a two way communication's interface as claimed in claim 5.
 3. Regarding claim 12, also billing/charging the client for made IPPV purchases is disclosed by D1 (paragraph 0099).
8. The present system/method relates to electronics and in particular to the design of a system for later production of devices that are manufactured by industry. Thus, the present claims possess industrial applicability.

**INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(SEPARATE SHEET)**

International application No.

PCT/US2004/001747

J Lindgren